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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,856	11/07/2001	Eric Terranova	05725.0947	8018

7590 11/10/2003

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EXAMINER

ELHILO, EISA B

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/890,856

Applicant(s)

TERRANOVA ET AL.

Examiner

Eisa B Elhilo

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23, 25, 26, 31, 34, 37, 40, 43, 46, 49, 52, 55, 58 and 64 is/are rejected.
- 7) ☒ Claim(s) 24, 27-30, 32, 33, 35, 36, 38, 39, 41, 42, 44, 45, 47, 48, 50, 51, 53, 54, 56, 57, 59-63 and 65-74 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claims 23-74 are pending in this application.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23, 25-26, 31, 34, 37, 40, 43, 46, 49, 52, 55, 58 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim et al. (US 5,993,491).

Lim (US' 491) teaches a hair dyeing comprising 1-(4-aminophenyl) pyrrolidine compounds having a formula 2 (see col. 4, formula 2), which is structurally similar to the claimed formula (I), when in the claimed formula (I), R1, R2, R3, R4 and R5 are hydrogen atoms and n = 1. Lim teaches the 1-(4-aminophenyl) pyrrolidine compounds in the amount of 0.01 to 10% by weight based on the total weight of the composition as claimed in claims 31 and 35 (see col. 7, lines 44-48), from 0.01 to 10% of couplers such as m-phenylenediamine and m-aminophenol as claimed in claims 37, 40, 43, 46, (see col. 6, line 16 and col. 7, 16-36), other oxidation bases in the amount of 0.01 to 10% such as para-aminophenols as claimed in claims 49 and 52 (see col. 5, lines 43-58 and col. 7, lines 49-51). Lim also teaches a hair dyeing composition acid addition salts such as sulfate salt as claimed in claim 55 (see col. 3, lines 7-8). Lim also, teaches a process for dyeing the oxidation dyeing of keratin fibers comprising applying to the fibers the dyeing composition as described above with the oxidant shortly before use as

claimed in claim 58 (see col. 10, lines 24-30). Lim further, teaches a multi-compartment device for dyeing kit as claimed in claim 64 (see col. 11, lines 1-9).

The instant claims differ from the reference by reciting a composition comprising oxidation base of para-phenylenediamine compound having an azetidiny group (4-membered hetero ring having one nitrogen atom).

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make such a composition because the reference teaches a dyeing composition comprising oxidation base of para-phenylenediamine compound having a pyrrolidinyl group (5-membered hetero ring having one nitrogen atom) (see col. 4, formula 2), and, therefore, nothing unobvious is seen in substituting the claimed compounds for the structurally similar compounds taught by Lim since structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results.

Allowable Subject Matter

2 Claims 24, 27-30, 32-33, 35-36, 38-39, 41-42, 44-45, 47-48, 50-51, 53-54, 56-57, 59-63 and 65-74 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record (US 5,993,491) does not teach or disclose a method for dyeing hair comprising applying to the hair a dyeing composition comprising para-phenylendiamine of the claimed compounds. Accordingly, the claimed subject matter as a whole would not have been obvious to one having ordinary skill in the art of hair dyeing formulations.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (703) 305-0217. The examiner can normally be reached on M - F (7:30-5:00) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (703) 308-0661. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Eisa Elhilo
Patent Examiner
Art Unit 1751

October 31, 2003.